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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,285	10/27/2004	Lionel Breton	112701-432	6015
29157 7590 06/18/2008 BELL, BOYD & LLOYD LLP P.O. Box 1135 CHICAGO, IL 60690				
EXAMINER BARNHART, LORA ELIZABETH				
ART UNIT		PAPER NUMBER		
1651				
NOTIFICATION DATE		DELIVERY MODE		
06/18/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

### Office Action Summary

**Application No.**

10/505,285

**Applicant(s)**

BRETON ET AL.

**Examiner**

Lora E. Barnhart

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendments***

Applicant's reply received 3/24/08 have been entered. No claims have been amended, added, or canceled in this reply. Only claim 9 remains pending in the current application. Prior art references not included with this Office action can be found in a prior action.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 9 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Shields, Jr. et al. (2000, U.S. Patent 6,156,355) taken in view of Spangler et al. (2003, U.S. Patent 6,524,574) and Hanna (1976, U.S. Patent 3,946,123). The claim is drawn to

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a pet food composition comprising at least  $10^5$  cfu probiotic lactic acid bacterium or culture supernatant thereof and at least  $10^5$  cfu yeast per gram of the composition, said composition further comprising between  $10^{-12}\%$  and 20% of at least one carotenoid.

Shields teaches dog food formulations comprising dried yeast, vitamin A, beta carotene, probiotic bacteria (*Lactobacillus acidophilus* and *Enterococcus faecium*), and fermentation extracts of probiotic bacteria (*Bacillus subtilis*, *Aspergillus oryzae*, and *Aspergillus niger*), as well as numerous sources of protein, fat, and fiber (Examples 5 and 6; note in particular column 21, lines 48-49; 50-51; 54; and 60-63).

Shields, Jr. et al. do not explicitly teach the particular amounts of probiotic bacteria, yeast, or carotenoids in their composition.

Spangler teaches a pet food formulation comprising  $3.3 \times 10^8$  cfu of probiotic lactic acid-producing bacterium (*Enterococcus* or *Lactobacillus*) and the yeast *Saccharomyces cerevisiae* per gram of the food formulation (column 4, lines 50-52, and column 5, lines 20-26 and 34-38)<sup>1</sup>. Spangler teaches that the amounts of the bacteria and yeast relative to each other and to the composition may be varied as required by the person of ordinary skill in the art (column 4, line 66, though column 5, line 28).

Hanna teaches that carotenoids may be added to pet foods to impart desired color thereto and that the amount of carotenoid added is optimizable (column 3, lines 52-63).

The selection of the amount of probiotic bacteria, yeast, and carotenoids to be included in the composition of Shields, Jr. et al. would have been a routine matter of

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<sup>1</sup>  $150 \times 10^9$  cfu per pound is equivalent to  $3.3 \times 10^8$  cfu per gram.

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optimization on the part of the artisan of ordinary skill, said artisan recognizing that Spangler and Hanna teach that amounts of these components within a pet food composition may vary depending on the animal's dietary needs and the desired properties of the food composition. Furthermore, Shields, Jr. et al. teach that the nutritional needs of dogs, for example, vary by breed type (column 4, line 63, through column 5, line 33). A holding of obviousness over the cited claims is therefore clearly required, absent a showing of unexpected results. See *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

Therefore, the invention as a whole would have been *prima facie* obvious to a person of ordinary skill at the time the invention was made.

Applicant alleges that the instant composition has unexpected properties in that it exerts a photoprotective effect on the skin of the pet that ingests it (Reply, page 2, paragraph 4; and page 4, paragraph 2). Applicant alleges that the cited references are non-analogous art (Reply, page 2, last paragraph et seq.). Applicant alleges that the claims are drawn to a composition for skin photoprotection, so the art does not address the problem with which applicant is concerned (Reply, page 3, paragraph 2). Applicants allege that the instant composition has a synergistic effect (Reply, page 3, last paragraph et seq., and page 4, paragraph 3). These arguments have been fully considered, but they are not persuasive.

The instant claim makes no reference to photoprotection or any alleged "synergistic effect." The claim is drawn simply to a pet food composition comprising three specific components. Although the claims are interpreted in light of the

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specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In any case, applicant has provided no evidence that the particular amounts of the components are inventive with respect to photoprotection or any other result. The specification alleges that the instant composition has a synergistic photoprotective effect on skin (see page 4, lines 4-8, and page 9, lines 19-20) but includes no experimental data to show that this is the case. In the recent decision *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007), the Supreme Court reiterated the propriety of the standard set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) for determining obviousness under 35 U.S.C. 103(a), which includes “objective evidence present in the application indicating obviousness or nonobviousness.” *Id.* at 17. The rejection of record complies with the standard set forth in *Graham v. Deere* and reiterated in *KSR*; applicant has provided no objective evidence of secondary considerations (e.g., unexpected results) that would obviate the rejection. The allegation in the specification and arguments of “synergistic effects” is completely unsubstantiated by experimental data. Furthermore, “synergy” by definition refers to an interaction between two active agents such that the combined effect is greater than the sum of the individual effects of each agent; it is not clear which agents are interacting synergistically.

Applicant's arguments regarding non-analogous art are unpersuasive. “Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for

combining the elements in the manner claimed.” See KSR at 1397. The instantly claimed composition, like the compositions of the cited prior art, is a nutritionally complete pet food. Applicant's arguments overlook the fact that the problem allegedly sought to be solved by the instant invention is not the only one that is addressed by the disclosure. All of the cited art is concerned with pet nutrition. Especially given the fact that the instant claims do not refer to photoprotection, this argument is unpersuasive.

***The claim is not allowed. The claim is not free of the art.***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lora E. Barnhart whose telephone number is (571)272-1928. The examiner can normally be reached on Monday-Thursday, 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sandra Saucier/  
Primary Examiner, Art Unit 1651

/Lora E Barnhart/  
Examiner, Art Unit 1651